

Appln No. 09/747,677

Amdt date April 23, 2004

Reply to Office action of December 23, 2003

REMARKS/ARGUMENTS

Claims 52-89 will be pending in this application after entry of the above amendments. Claims 52-53, 55-56, 58-59, 61, 64-65, 67-68, 70-71 and 73 have been amended, and claims 76-89 have been added. The amendments find full support in the original specification, claims, and drawings. No new matter has been added. In view of the above-amendments and remarks that follow, Applicant submits that claims 52-89 are in condition for allowance, and respectfully requests an early indication of their allowance.

Claims 52-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,615,408 to Kaiser et al. in view of U.S. Patent no. 5,861,881 to Freeman et al.

Kaiser discloses a system and method for providing action selections for an image referencing a product in a video production. (See, Abstract). FIG. 3 of Kaiser discloses a reproducing apparatus 1300 including a trigger interpreter 1330, ASI (action selection interface) interpreter 1320, and content integrator 1310. Kaiser teaches that the trigger interpreter 1330 interprets triggers in the video production 110 and sends a request 1340 via the data network 1400 to a remote action resource provider 1500. If an action selection interface is available for the particular trigger, the action resource provider 1500 communicates an ASI indication 1360 to the reproducing apparatus 1300. The ASI indication is then used to provide a visual indication of the availability of an ASI. The action resource provider 1500 also transmits an ASI

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characterization 1380 to the reproducing apparatus. When displayed, the rendered characterization includes various actions that may be selected by a user via a selection device.

The Examiner relies on the visual highlight shown in Figure 6B of Kaiser to contend that it reads on the recited mask overlay. However, nothing in Kaiser teaches or suggests receiving a "viewer actuation" of the mask overlay as is required by amended independent claims 52, 55, 58, 61, 64, 67, 70, and 73. The Examiner contends that "Kaiser teaches receiving selection input identifying an overlay by selecting an action to be performed." (Office action, p. 3, lines 4-6). However, the amended claims require more than just an identification of a mask overlay. The amended claims now require a "viewer actuation" of the mask overlay. Thus, even the combination of Kaiser and Freeman fail to teach or suggest all of the elements of the independent claims.

Even if, *arguendo*, Kaiser did disclose a "viewer actuation" of a mask overlay, the Examiner acknowledges that Kaiser is silent about switching from one video stream to a second stream. The Examiner, however, relies on the teachings of Freeman to make up for this deficiency. In doing so, the Examiner proposes modifying Kaiser by switching the video streams as taught by Freeman "in order to increase user interactivity and provide desirable programming to the user." (Office action, p. 3, lines 8-11). Applicant respectfully submits that there is no prior art motivation to modify the Kaiser system in the manner suggested by the Examiner.

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First, there is no prior art indication that the user interactivity provided by Kaiser's system is deficient to make a person of skill in the art want to, that is, feel motivated to, modify Kaiser to increase user interactivity as is suggested by the Examiner.

Second, there is no prior art indication that allowing Kaiser's system to switch from one video stream to another would actually increase user interactivity.

Third, there is no prior art indication that Kaiser's system fails to provide "desirable programming to the user" to motivate a person of skill in the art to modify Kaiser's system in the manner proposed by the Examiner. Thus, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to independent claims 52, 55, 58, 61, 64, 67, 70, and 73. These claims are therefore now in condition for allowance.

Claims 53-54, 56-57, 59-60, 62-63, 65-66, 68-69, 71-72, and 74-75 are also in condition for allowance because they depend on an allowable base claim, and for the additional limitations contained therein.

Claims 76-89 are new in this application. Applicant submits that these claims are also in condition for allowance because none of the cited references teach or suggest the limitation recited therein.

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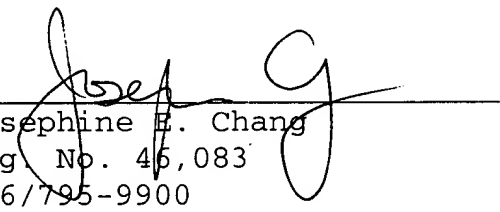
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In view of the above amendments and remarks, Applicant respectfully requests reexamination, reconsideration, and an early indication of the now pending claims 52-89.

Respectfully submitted,

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